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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,314	10/24/2003	Takashi Horai	890050.445	1460
500 7590 08/21/2007 SEED INTELLECTUAL PROPERTY LAW GROUP PLLC 701 FIFTH AVE SUITE 5400 SEATTLE, WA 98104			EXAMINER BIBBINS, LATANYA	
			ART UNIT 2627	PAPER NUMBER
			MAIL DATE 08/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/693,314

Applicant(s)

HORAI ET AL.

Examiner

LaTanya Bibbins

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 6, 2007 has been entered.

Response to Arguments

2. Applicant's arguments filed June 5, 2007 have been fully considered but they are not persuasive.

3. The affidavits filed on June 5, 2007 under 37 CFR 1.131 have been considered but are ineffective to overcome the Shirota et al. (USPGPub 2003/0067857 A1) reference.

Signed statements indicating that the non-signing inventor is no longer an employee of the company is ineffective to overcome the Shirota reference. As indicated in the Advisory Action mailed on July 9, 2007, the declarations filed under 37 CFR 1.131 must be submitted by the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under 37 CFR 1.42, 1.43, or 1.47. In addition, as outlined in MPEP 715.04, the following parties may make an affidavit or declaration under 37 CFR 1.131:

- a) All the inventors of the subject matter claimed,
- b) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection,
- c) If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate, or
- d) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor.

Further, as outlined by 37 CFR 1.47, when an inventor refuses to sign or cannot be reached:

- a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(g), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.
- b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise

shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in § 1.17(g), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

- c) The Office will send notice of the filing of the application to all inventors who have not joined in the application at the address(es) provided in the petition under this section, and publish notice of the filing of the application in the Official Gazette. The Office may dispense with this notice provision in a continuation or divisional application, if notice regarding the filing of the prior application was given to the nonsigning inventor(s)

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Shirota et al. (US PGPub 2003/0067857 A1).

Claim 1 recites a data recording method of modulating the power of a laser beam in accordance with a pulse pattern, projecting the laser beam onto a write-once type optical recording medium, and recording data in the write-once type optical recording medium. The power of the laser beam is set to a recording power P_w within a first period and a second period and set to an intermediate power P_m , lower than the recording power, within a third period provided between the first and second periods. The length of the first period and the levels of P_w and P_m satisfy $1.7T \leq t_{top2}$ and $1.4 \leq P_w/P_m \leq 1.62$, where T is the period of a reference pulse and t_{top2} is the length of the first period. Shirota discloses an information recording method of generating a recording pulse signal and irradiating a laser beam on a recording medium, wherein the recording pulse signal includes a mark period in which a recording mark is formed. The mark period includes a top pulse period having a first recording power and an intermediate bias period having a second recording power that is lower than the first recording power (see paragraph [0028]). The length of the top pulse, T_{top} , is defined in paragraph [0120] as $1.75T$. In paragraph [0027] Shirota discloses the relationship between the first and second recording powers where the first recording power is in the range of 120% to 185% of the second recording power. In the description of the preferred embodiments, paragraph [0053], Shirota further discloses various types of optical disks to be used, including CD-R and DVD-R types, which record information only once.

Claim 2 is drawn to the method of claim 1 where the length of the first period satisfies $1.7T \leq t_{top2} \leq 2.0T$ and the recording and intermediate powers satisfy $1.4 \leq P_w/P_m \leq 1.62$. Shirota clearly discloses the length of the top pulse, T_{top} , equal to $1.75T$ in paragraph [0120] and the relationship between the first and second recording powers where the first recording power is in the range of 120% to 185% of the second recording power in paragraph [0027].

Claim 3 is drawn to the recording method of claim 1 where the linear recording velocity is greater than or equal to 14m/s during recording in the write-once type optical recording medium. Paragraph [0019] of the disclosure states "a linear recording velocity equal to or higher than 14 m/s, which corresponds to the 4x speed of the DVD-R." In paragraph [0088] of the reference, Shirota states that Figure 6 shows examples of a recording pulse-waveform for high-speed recording, which is four times faster than the normal recording speed. Since Shirota's invention relates to DVD's and high-speed recording, the normal speed is interpreted as the speed DVD-R's and DVD-RW's

Claim 4 is drawn to the method of claim 2 where the linear recording velocity is greater than or equal to 14m/s during recording in write-once type optical recording medium. In paragraph [0088] of the reference, Shirota states that Figure 6 shows examples of a recording pulse-waveform for high-speed recording, which is four times faster than the normal recording speed. Since Shirota's invention relates to DVD's and high-speed recording, the normal speed is interpreted as the speed DVD-R's and DVD-RW's.

Claim 5 is drawn to the method of claim 1 where record marks (including 5T) are formed in the write-once type optical recording medium. Shirota discloses a recording method as described above where 5T to 14T marks are formed (see Figure 6).

Claim 6 is drawn to the method of claim 2 where record marks (including 5T) are formed in the write-once type optical recording medium. Shirota discloses a recording method as described above where 5T to 14T marks are formed (see Figure 6).

Claims 7 and 8 are drawn to the apparatus corresponding to the method of using the same as claimed in claims 1 and 2 respectively. Therefore apparatus claims 7 and 8 correspond to method claims 1 and 2, and are rejected for the same reasons of anticipation stated above.

Claim 9 recites a write-once type optical recording medium where data can be recorded by modulating the power of a laser beam in accordance with a pulse pattern, projecting the laser beam onto a write-once type optical recording medium and recording data in the write-once type optical recording medium. The power of the laser beam is set to a recording power P_w within a first period and a second period and set to an intermediate power P_m , lower than the recording power, within a third period provided between the first and second periods. The length of the first period and the levels of P_w and P_m satisfy $1.7T \leq t_{top2}$ and $1.4 \leq P_w/P_m \leq 1.62$ where T is the period of a reference pulse and t_{top2} is the length of the first period. Claim 9 is drawn to the write once optical recording medium corresponding to the method of claim 1. Therefore claim 9 is rejected for the same reasons of anticipation as used in claim 1 above.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota et al. (US PGPub 2003/0067857 A1) as applied to claim 9 above, and further in view of Usami et al. (US PGPub 2003/0169679 A1).**

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claim 11 is drawn to a write once type optical recording medium and includes a light transmittable substrate, a dummy substrate, and a recording layer containing organic dye, provided between the light transmittable substrate and the dummy substrate. Shiota does not teach a write once type optical recording medium with a light transmittable substrate, dummy substrate and recording layer containing organic dye provided between the light transmittable and dummy substrates. However, Usami et al. teaches an optical recording medium formed by stacking a recording layer and a protective layer or dummy substrate onto a substrate (refer to Figure 3). Usami discloses that the substrate layer can be formed of light transmittable materials such as polycarbonate and epoxy resins (see paragraph [0051]). Usami also discloses dyes to

be used in the recording layer such as cyanine dye (an organic dye) in paragraph [0064].

It is apparent that one of ordinary skill in the art, at the time the invention was made, would have been motivated to combine the teachings of Shirota with Usami and would have had a reasonable expectation in producing the claimed invention because Shirota and Usami teach analogous art. Specifically, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use the optical recording medium described by Usami. Usami provides motivation in paragraph [0011] by stating the stable recording and reproducing characteristics of the optical recording medium. Therefore the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, absent unexpected results to the contrary.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaTanya Bibbins whose telephone number is (571) 270-1125. The examiner can normally be reached on Monday through Friday 7:30 am - 5:00 pm.

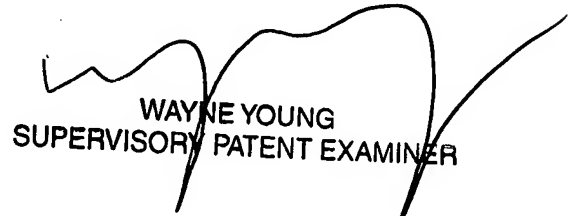
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on 571 272-7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2627

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



LaTanya Bibbins



WAYNE YOUNG
SUPERVISORY PATENT EXAMINER